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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/444,774	11/22/1999	MICHAEL G MIKURAK		9073

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OPPENHEIMER WOLFF & DONNELLY, LLP (ACCENTURE)
1400 PAGE MILL ROAD
PALO ALTO, CA 94304

EXAMINER

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 04/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/444,774

Applicant(s)

MIKURAK, MICHAEL G

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-69 is/are pending in the application.
- 4a) Of the above claim(s) 19-30, 36-47 and 53-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-35, 48-52 and 65-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 19-30, 36-47 and 53-64 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

1. Claims 31-35, 48-52, 65-69 have been examined.

Response to Amendment

2. The Amendment filed on 3/24/03 is insufficient to overcome the Abgrall and Gerace reference.

Election/Restrictions

3. Newly submitted claims 19-69 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Original claims 1-19 claimed an invention entirely different than the claims amended on 3/24/03 and numbered claims 19-69. Applicant has taken the original invention and original claims of 1-5, 7-11, and 13-17 and added them to an entirely new invention and entirely new claims as expressed in claims 19-30, 36-47, and 53-64.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19-30, 36-47, and 53-64 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

4. Claims 31, 48, and 65 are stated as dependent upon claims 19, 37, and 53 respectively. However, the claims 19, 37, and 53 no longer exist. Therefore, the claims 31, 48, and 65 and their dependent claims are improper. Correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 31-33, 35, 48-50, 52, 65-67, 69 are rejected under 35 U.S.C. 102(e) as being unpatentable over Abgrall (6,373,498).

Claims 31, 48, and 65: Abgrall discloses a method, program, and apparatus for displaying content to a user based on a profile (Abstract and col 3, lines 28-31). Abgrall further discloses identifying a user (col 8, lines 49-51; col 3, lines 8-11; and Fig. 1), collecting

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information about the user wherein the information relates to the installation of a service (col 3, lines 1-8), building a profile of the user based on the collected information (col 3, lines 10-15), managing a plurality of different contents (col 2, lines 23-33), analyzing the profile and the contents in order to match attributes of the profile of the user and attributes of the contents (col 9, lines 25-55), selecting the contents which have attributes that match the attributes of the profile of the user (col 9, lines 40-42), and delivering the selected contents to the user (col 9, lines 40-42).

Claim 32, 49, and 66: Abgrall discloses a method, program, and system as in claims 1, 7, and 13, and further discloses that the step of analyzing the profile occurs in real time (col 9, lines 50-55 and col 10, lines 20-29).

Claim 33, 50, and 67: Abgrall discloses a method, program, and system as in claims 1, 7, and 13, and further discloses identifying a time when the user last viewed the contents, and indicating portions of the contents that have been modified or added since the time when the user last viewed the contents (col 3, lines 10-15; col 4, lines 26-31; col 11, lines 34-35; and col 10, lines 20-25).

Claim 35, 52, and 69: Abgrall discloses a method, program, and system as in claims 1, 7, and 13, and further discloses allowing the user to rate the contents (col 4, line 67-col 5, line 7 and col 10, lines 22-25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 34, 51, and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abgrall (6,373,498) in view of Gerace (5,991,735).

Claims 34, 51, and 68: Abgrall discloses a method, program, and system as in claims 1, 7, and 13. Abgrall further discloses that the user is identified by receiving user input (col 4, line 67-col 5, line 7 and col 10, lines 22-25) and that digital signatures are used (col 9, lines 3-11).

Abgrall further discloses profiling the user utilizing a variety of means (col 3, lines 1-15), utilizing a website and downloaded software to assist in the user identification and profiling (col 4, lines 20-27; col 4, line 65-col 5, line 6), and that the system can utilize the Internet and websites (col 2, lines 35-45; col 2, lines 22-26).

Abgrall does not explicitly disclose the use of cookies to identify a user.

However, Gerace discloses identifying a user and his preferences using cookies (col 13, line 59- col 14, line 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gerace's utilization of cookies to Abgrall's user profiling and content delivery method, program, and system. One would have been motivated to do this so that Abgrall can track users utilizing a method common to the industry that provides ease of management when interacting with the Internet.

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Response to Arguments

7. Applicant's arguments with respect to claims 31-35, 48-52, 65-69 have been considered but are found not persuasive. Please see the rejection above.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

April 7, 2003

JAMES W. MYHRLE
PRIMARY EXAMINER
ART UNIT 3622